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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/531,369	03/21/00	WILLIAMSON	M 07334-122001

ANITA L MEIKLEJOHN PH.D  
FISH AND RICHARDSON PC  
225 FRANKLIN STREET  
BOSTON MA 02110-2804

HM12/1113

EXAMINER

CANELLA, K

ART UNIT	PAPER NUMBER
1642	9

DATE MAILED: 11/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/531,369

Applicant(s)

Williamson

Examiner

Karen Canella

Group Art Unit

1642



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, drawn to a method for identifying compounds which modulate drug resistance in a cell comprising identifying compounds which change the level of expression or activity of MDA-9 in a cell, classified in class 435, subclass 4.
  - II. Claims 4-13, drawn to methods for identifying drug resistant phenotypes and methods for monitoring the effects of anti-tumor treatment comprising measuring MDA-9 expression or activity, classified, for example, in class 435, subclass 7.1.
  - III. Claims 14-17 and 19, drawn to a method for increasing effectiveness of a chemotherapeutic compound, a method for lowering the drug resistance of a cell comprising administering a compound which reduces the expression of MDA-9, or a MDA-9 antagonist, classified, for example, in class 514, subclass 44. Claim 14 will be examined with this group to the extent that it reads on lowering drug resistance in a cell.
  - IV. Claims 14 and 18, drawn to methods for increasing drug resistance in a cell comprising administering compounds which increase the expression of MDA-9, classified, for example, in class 424, subclass 93.1. Claim 14 will be examined with this group to the extent that it reads on increasing drug resistance in a cell.
  - V. Claim 20, drawn to a pharmaceutical composition comprising an inhibitor of MDA-9 expression, classified, for example, in class 536, subclass 24.5.
2. The inventions are distinct, each from the other because of the following reasons:

The methods of Groups I, II, III and IV differ in the method objectives, method steps and parameters and in the reagents used.

Inventions V and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the


product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the antisense DNA of invention V can be used in an in vitro mutagenesis assay.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
GEETHA P. BANSAL  
PRIMARY EXAMINER

Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

November 6, 2000